

### **REMARKS**

Claims 1-18 are currently pending in the application. Of those, claims 1, 4, 12 and 15 are in independent form.

No claims are amended, canceled or added.

### **CLAIM OBJECTIONS**

The Office Action indicates that claims 10, 11, 13, 14, 16 and 17 include allowable subject matter. However, the Office Action objects to the claims as being dependent upon a rejected base claim, but indicates they would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant respectfully submits that the base claims from which these claims depend are in condition for allowance. The claims have therefore not been amended to include all the limitations of their base and intervening claims.

### **CLAIM REJECTIONS UNDER 35 U.S.C. § 103(a)**

The Office Action rejects claims 1-9, 12, 15, and 18 under 35 U.S.C. § 103(a) as unpatentable over Japanese Patent Document No. 2002-199151 to Moriya et al. (hereinafter "Moriya") in view of U.S. Patent Publication No. 2003/0208546 of DeSalvo et al. (hereinafter "DeSalvo"). These rejections are respectfully traversed.

***Moriya and DeSalvo do not "discriminate, based on a header of the E-mail, the type the transmitting terminal."***

The Office Action asserts that DeSalvo discloses, in paragraphs [0026] and [0028], discriminating, "based on a header of an E-mail, the type of the transmitting terminal which transmits the E-mail to be received by the image-attached mail transiting apparatus," as variously recited by independent claims 1, 4, 12, and 15. However, DeSalvo discloses only that the type of file might, in one instance, be determined by first "searching the e-mail message for an attachment header" to determine if an attachment exists (paragraph [0026]), then identifying "the

attachment type directly from the attachment header” (paragraph [0028]). The Office Action suggests that DeSalvo then determines the type of transmitting terminal based on the attachment type. Applicants respectfully submit that: 1) mere determination of the file type of an attachment could only in very rare circumstances (irrelevant to the present issue)<sup>1</sup> directly identify/discriminate the type of the transmitting terminal, and 2) even if, for the sake of argument, discrimination of the type of the transmitting terminal could be made based on file attributes utilized by the DeSalvo device (not conceded), the devices disclosed by DeSalvo and Moriya are not configured to make or perform the claimed discrimination.

Nor does DeSalvo disclose that “attributes or complexity” of an attached file are acquired or analyzed for the purpose of facilitating the Office-Action alleged discrimination of the type of transmitting terminal. (OA, page 4.) The receiving-device oriented file conversion described by DeSalvo may, conceivably, require determination of certain attachment file characteristics (e.g., file size or dimensions, compression, color depth). However, such characteristics need not, and are not disclosed by DeSalvo to include the type of the transmitting terminal.

***File attributes “based on” attachment type do not discriminate the type of transmitting terminal.***

Moreover, even if the file attributes utilized by Moriya and/or DeSalvo were disclosed in or based on an E-mail header, those attributes cannot alone be utilized to discriminate the type of transmitting terminal of a received E-mail to which an image file is attached. If discrimination of the type of transmitting terminal is somehow possible based on the file attributes disclosed by DeSalvo to be part of or derived from an E-mail header, such discrimination, nevertheless, is not disclosed by the prior art of record. Applicants respectfully request the Examiner to provide support for the asserted discrimination of the type of the transmitting terminal which transmits an E-mail to the transiting apparatus, the discrimination based on attachment file attributes disclosed by Moriya or DeSalvo and considering only such attributes as are “based on a header of the E-mail” (and not a header of the attached image).

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<sup>1</sup> E.g., if a proprietary file type was known to originate only from a particular device.

DeSalvo and Moriya do not, alone or in combination, disclose that the determined file type of an attachment to an E-mail, or “attributes and complexity” of the attachment, have any relationship with the type of transmitting terminal that sends the E-mail.

***Moriya does not disclose substitution of an E-mail attachment, and subsequent transmission of the attachment-substituted E-mail.***

The Office Action asserts that Moriya discloses “wherein an image processed by the image processing unit is substituted for the attached image of the E-mail, and then an altered E-mail, to which the substituted image is attached, is transmitted to a receiving terminal,” as variously recited in independent claims 1, 4, 12, and 15 of the present application. Applicants respectfully disagree.

Moriya discloses “mail terminals 20A and 20C which carry a digital camera [and] are connected respectively to cellular phones 10A and 10C” and an internet-connected server 100 that serves as an image processing device. (Paragraph [0034]). However, none of the Moriya devices alters an E-mail by substituting a processed image for a corresponding unprocessed image, nor transmits the altered E-mail to a receiving terminal. For that matter, Moriya does not disclose that an E-mail to which a processed image is attached is sent from the server 100. Instead, the processed image either “shall be saved in the server 100 as data for download to an image output device” (paragraph [0044]) or “is transmitted to an image output device from the image data output part 180A” (paragraph [0062]).

Claims 2-3, 5-9, and 18 depend from one of the base claims argued above, and are therefore believed to be in condition for at least the same reasons as their base claims. Withdrawal of the rejection and reconsideration of the claims are respectfully requested.


**CONCLUSION**

In view of the above amendment, applicant believes the pending application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact James C. Larsen, Reg. No. 58,565 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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